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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,795	02/25/2005	Norihito Ohi	0425-1154PUS1	9627

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BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

NOLAN, JASON MICHAEL

ART UNIT	PAPER NUMBER
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1626

NOTIFICATION DATE	DELIVERY MODE
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12/12/2007

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary	Application No. 10/509,795	Applicant(s) OHI ET AL.	
	Examiner Jason M. Nolan, Ph.D.	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20,22,23 and 49-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20,22,23,49 and 50 is/are rejected.
- 7) ☒ Claim(s) 51 and 52 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>9/24/04; 9/28/07</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office Action is responsive to Amendment – After Non-Final Rejection, filed **09/28/2007**. **Claims 20, 22, 23, & 49-52** are pending in the instant application; of which, **Claims 20, 22, 23, 49, 51, & 52** are currently amended. **Claims 1-19, 21, 24-48, & 53-62** are canceled.

Information Disclosure Statement

Applicants' information disclosure statement (IDS), filed **09/24/2004** - attached, has been lined through because all references are on the IDS, filed **09/26/2006**. The IDS, filed **09/28/2007** - attached, has been considered.

Response to Amendment

Applicant's amendments have been fully considered and are entered. The 112, 1st enablement rejection of **Claims 53-55 & 59-62** is withdrawn per amendment. The 102 prior art rejection of **Claims 20 & 22** is withdrawn per Applicants argument. The 112, 2nd indefinite rejection of **Claim 49** is withdrawn per amendment. The ODP rejection of **Claims 20, 22, 23, & 50** is maintained. Amendment to **Claim 20** with the limitation of **Claim 21** does not obviate the overlap of the instant application with US application 10/447,948. The claim objection to **Claim 23** is withdrawn per amendment. Further, new prior art rejections are presented herein.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 20, 22, 23 and 50 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over **Claims 20, 22, 23, and 50** of copending Application No. **10/447,948**. Although the conflicting claims are not identical, there is substantial overlap between said claims. Therefore, a reference or case of infringement that anticipates or renders obvious the claims of one application may also anticipate or render obvious the claims of the other application.

Furthermore, both applications are drawn to compounds and compositions of the formula (III), which have been found useful for the inhibition of the JNK kinases. Therefore, one of ordinary skill in the art when faced with copending application **10/447,948** would be motivated to prepare applicants' instant elected invention as the conflicting claims generically encompass the instantly claimed application, specifically wherein R^e represents halogen. The motivation would be to prepare additional compounds for the inhibition of JNK kinases. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

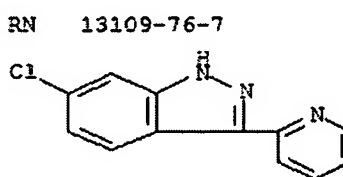
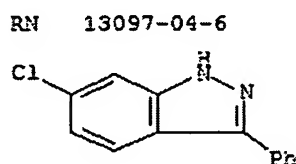
Claim 23 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Specifically, the claim is drawn to compounds of the formula (III) wherein at least one of R^b and R^c is not a hydrogen atom. There are numerous examples in the specification on pages 595-675 (see examples 1-1363); however, none of these examples are drawn to the claimed subject matter. So, there is not a representative number of examples and for this reason one of skill in the art would recognize that applicant was not in possession of species having these necessary features.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 20 & 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Horner *et al.* (DE 1266763, 04/25/1968). Shown below are compounds RN 13097-04-6 and RN 13109-75-7 which anticipates the instant claims wherein $R^e = Cl$ and $R^1 =$ a substituted aryl or heteroaryl.

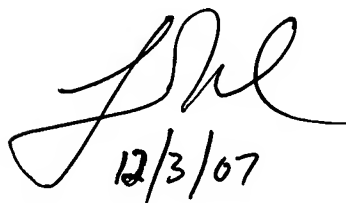


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following prior art documents, among others, contain species that anticipate the instant application:

1. Mohr *et al.* DE 1168437 04/23/1964.
2. Piozzi *et al.* *Gazzetta Chimica Italiana* **1965**, 95(7), 814-24.
3. Gorog *et al.* US Patent 3,705,175 12/05/1975.
4. Burmistrov *et al.* *Khimiya Geterotsiklicheskikh Soedinenii* **1973**, 2, 249-51.
5. Claverie *et al.* *Farmaco, Edizione Scientifica* **1973**, 28(7), 523-7.
6. Wasley *et al.* US 3,755,332 08/28/1973.
7. Takayama *et al.* JP 50157363, 12/19/1975.
8. Krishnan *et al.* *J. Heterocyclic Chem.* **1988**, 25(2), 447-52.

Telephone Inquiry

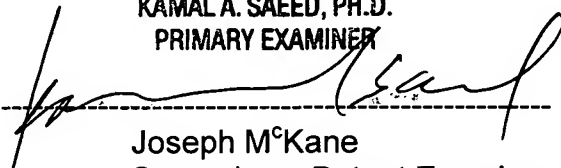
Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jason M. Nolan, Ph.D.** whose telephone number is **(571) 272-4356** and electronic mail is **Jason.Nolan@uspto.gov**. The examiner can normally be reached on Mon - Fri (9:00 - 5:30PM). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Joseph M^cKane** can be reached on **(571) 272-0699**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



12/3/07

Jason M. Nolan
Patent Examiner
Art Unit 1626
(571) 272-4356

KAMAL A. SAEED, PH.D.
PRIMARY EXAMINER



Joseph M^cKane
Supervisory Patent Examiner
Art Unit 1626
(571) 272-0699